

Appl. No. 09/769,686
Amdt. Dated 11/8/2005
Reply to Office Action of 08/08/05

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed August 8, 2005. In the Office Action, claims 13-16, 30-33 and 47-50 were objected and identified as including patentable subject matter. Claims 1-12, 17-29, 34-46 and 51 were rejected under 35 U.S.C. §103. Applicants respectfully traverse the rejection and respectfully request reconsideration of the pending claims based on the remarks made herein.

Telephonic Interview

Applicants respectfully request an Examiner's Interview with the Examiner if, after review of the Amendment, continues to believe that the pending claims are not in condition for allowance. The Examiner's Interview will greatly facilitate prosecution of the subject application. The undersigned attorney may be reached at the phone number listed below.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication of allowable subject matter. The Examiner objects to claims 13-16, 30-33 and 47-50 as being dependent on a rejected base claim, but indicates that the claims would be allowable if rewritten in independent form. Applicants believe that independent claims 1, 18 and 35 are in condition for allowance, and thus, no amendments have been made to the objected claims at this time. Applicants respectfully request reconsideration of the allowability of the pending claims.

Rejection Under 35 U.S.C. § 103

Claims 1-3, 5, 10-12, 17-20, 22, 27-29, 34-37, 39, 44-46 and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson (U.S. Patent No. 6,912,311) in view of Shimori (U.S. Patent No. 6,567,983). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988)*. Herein, at a minimum, the combined teachings of the cited references do not describe or suggest all the claim limitations.

With respect to claim 1, 18 and 35, each of these claims include the limitation of an image template containing a first edited image and a selected record of at least one image editing operation, where the image editing operation having been performed on a first image to obtain the first edited image. It is contended by Applicants that neither Anderson nor Shimori, alone or

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in combination, teach or suggest the image editing operation *having been performed on a first image to obtain the first edited image*. Emphasis added.

According to the Office Action, the first edited image constitutes a plane file. *See pages 2-3 of the Office Action*. The "plane" is described in Anderson as ore-defined effects (graphics and text) which can be applied to an image in a specified order. The plane file stores instructions for the application of graphics for a plane. *See column 3, lines 52-55 of Anderson*. The Office Action further indicates that the selected record of at least one image editing operation constitutes the "template" file. *See page 3 of the Office Action*. The "template file" stores instructions for the application of planes to the image. *See column 3, lines 63-64 of Anderson*.

Hence, for this interpretation to be consistent with the claimed invention, the combined teachings of Anderson and Shimori would further need to suggest an image editing operation (template file per Examiner features an operation) that has been performed on a first image to obtain the first edited image (plane file per Examiner). In contrast, the template file involves instructions for the application of *planes (first edited image) to an image*, and is not directed to the operations that were applied to an image to produce the edited image (plane file per Examiner) as claimed.

Hence, withdraw of the outstanding rejection as applied to independent claims 1, 18 and 35 is respectfully requested.

In addition, based on the dependency of claims 2-3, 5, 10-12, 17, 19-20 22, 27-29, 34, 36-37, 39, 44-46 and 51 on independent claims 1, 18 and 35, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicants reserve the right to present such arguments in an Appeal is warranted. Withdrawal of the §103(a) rejection as applied to claims 1-3, 5, 10-12, 17-20 22, 27-29, 34-37, 39, 44-46 and 51 is respectfully requested.

Claims 4, 21 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Shimori and Rissman (U.S. Patent No. 6,552,743). Also, claims 6-7, 23-24 and 40-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Shimori and Enomoto (U.S. Patent No. 6,313,902). Applicants respectfully traverse these rejections on their own merit. However, based on the dependency of claims 4, 6-7, 21, 23-34, 38 and 40-41 on independent claims 1, 18 and 35, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicants reserve the right to present such arguments in an Appeal is warranted. Withdrawal of the §103(a) rejection as applied to claims 4, 6-7, 21, 23-34, 38 and 40-41 is respectfully requested.

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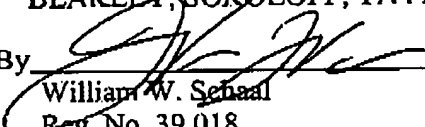
Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: November 8, 2005

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Susan McFarlane
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